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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,843	08/02/2001	Yoshihiko Obata	1506-1010	5667

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/919,843		OBATA, YOSHIHIKO	
	Examiner		Art Unit	
	John Van Bramer		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed February 27, 2006 cancelled no claims. Claims 1 – 11 were amended and Claim 12 was added. Therefore, the currently pending claims are Claims 1 – 12.

Claim Rejections - 35 USC § 101

2. The amendment filed February 27, 2006 corrected the deficiencies in Claim 9. Therefore, the Examiner hereby withdraws the USC 101 rejection detailed in the Office Action dated October 28, 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1, 3, and 6-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Bahar (U.S. Patent Number: 6,694,355).

Claim 1: Behar discloses a profit sharing method used for designing a product having a plurality of elements modifiable to adapt to fashion trends, the method being executed by a server computer and comprising:

- a. Providing participants with a questionnaire including a plurality of questions, each question concerning an element of the product, asking each participant to select one option from a plurality of options for the element of the product in each question. (Col 5, lines 36 – 56, and Fig. 3) (A questionnaire is not limited to text based representation. The outline Fig. 3, 302 shown a number of sections from which a user decides the type of part to use in each section. Therefore, each section represents a multiple-choice question. Since each section has multiple possible parts that can be selected, these parts represent possible answers to each multiple-choice question. Hence, Behar is providing participants with a questionnaire, with a plurality of questions and each question has a multiplicity of answers.)
- b. Retrieving answers to the questionnaire including pieces of answer information each specifying the one option for each question selected by a participant from the plurality of options corresponding to the element in each question. (Col 6, lines 12 – 17)
- c. Specifying one adopted option from the plurality of options of each question of the questionnaire corresponding to the element, based on the retrieved pieces of answer information. (Col 6, lines 29 – 41)
- d. Determining a final design of the product in which each element is as specified in the corresponding one adopted option. (Col 6, lines 29 – 41)
- e. Assigning predetermined points to each participant for each question if the participant selected the corresponding one adopted option from the plurality

- of options of the question. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col 6, lines 29 – 41)
- f. Determining an individual return value, which should be given to the participant in accordance with the predetermined points, assigned to the participant. (the award incentive) (Col 6, lines 29 – 41)

Claim 3: Bahar discloses a method according to claim 1, wherein each piece of answer information specifies, as to a plurality of elements, options which characterize the product, respectively. (Col 5, lines 36 – 56, and Fig. 3)

Claim 6: Bahar discloses a method according to claim 1, further comprising a step of creating image data of the product characterized by at least one adopted option (Col 6, lines 49-51).

Claim 7: Bahar discloses a profit sharing method executed by a client computer connectable to a server computer, the method comprising:

- a. Receiving a questionnaire including a plurality of questions, each question being directed to an element characterizing a commercial article. (Col 5, lines 36 – 56, and Fig. 3)
- b. Obtaining pieces of answer information each specifying at least one option selected by a participant from options corresponding to each question (Col 6, lines 12 – 17)

- c. Sending the obtained pieces of answer information to the server computer to determine said server computer to execute (Col 6, lines 13-16).
- d. Specifying one adopted option corresponding to the element, based on the pieces of answer information received from the client computer and determining a final design of the commercial article according to the one adopted option for each of the plurality of questions of the questionnaire. (Col. 6, lines 29-41).
- d. Assigning predetermined points to a participant who selected said one adopted option as the at least one option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 29-41)
- e. Determining individual return values that should be respectively given to participants in accordance with the predetermined points assigned to the participants. (Col 6, lines 29-41)

Claim 8: Bahar discloses a computer readable medium containing a profit sharing program comprising:

- a. A module making a server computer to issue a questionnaire including a plurality of questions, each question being directed to an element characterizing a commercial article, and having a plurality of options as possible answers to the question. (Col 5, lines 36 – 56, and Fig. 3)

- b. A module making the server computer to acquire pieces of answer information, each piece of information specifying at least an option selected for a question by a participant. (Col 6, lines 29-32 and lines 13-16).
- c. A module making the server computer to select for each question one option corresponding to the element, based on the acquired pieces of answer information and the determine a final design of the commercial article according to the adopted option for each element. (Col 6, lines 29-36).
- d. A module making the server computer to assign for each question predetermined points to a participant who selected the adopted option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 32-35)
- e. A module making the server computer to determine individual return values that should be respectively given to participants in accordance with the predetermined points assigned to the participants. (Col 6, lines 29-33)

Claim 9. Bahar discloses a computer readable medium containing executable code of a profit sharing method used for designing a product, the executable codes comprising:

- a. A first executable code making a server computer to issue a questionnaire including a plurality of questions, each question being directed to an element of a commercial article, and providing a plurality of options to be selected by a participant. (Col 5, lines 36 – 56, and Fig. 3)

- b. A second executable code making the server computer to acquire pieces of answer information each piece of answer information specifying an option selected by a participant for at least one question. (Col 6, lines 29-39 and lines 13-16).
- c. A third executable code making the server computer to specify an adopted option corresponding to the element for each question, based on the pieces of answer information and to determine a final design of the commercial article according to the adopted option for each element. (Col 6, lines 29-36).
- d. A fourth executable code making the server computer to assign predetermined points to a participant who selected the adopted option. (Col 6, lines 32-36)
- e. A fifth executable code making the server computer to determine individual return values that should be respective given to participants in accordance with the predetermined points assigned to the participants. (Col 6, 29-33)

Claim 10: Bahar discloses a profit sharing system comprising:

- a. A server computer connectable to a client computer. (Col 4, lines 55-58)
- b. A storing device containing a profit sharing program comprising. (Col 4, lines 7-9)
- c. A module making the server computer to issue a questionnaire including a plurality of questions, each question being directed to an element of a

- commercial article, and providing a plurality of options to be selected by a participant. (Col 5, lines 36 – 56, and Fig. 3)
- d. A module making the server computer to acquire pieces of answer information each specifying an option for at least one question selected by a participant from options corresponding to the element of the commercial article. (Col 6, lines 29-32 and lines 13-16).
 - e. A module making the server computer to specify an adopted option corresponding to the element, based on the acquired pieces of answer information and to determine a final design of the commercial article according to the adopted option for each element. (Col 6, lines 29-41).
 - f. A module making the server computer to assign predetermined points to a participant for each question when the participant selected the adopted option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 32-35)
 - g. A module making the server computer to determine individual return values that should be respectively given to participants in accordance with the predetermined points assigned to the participants. (Col 6, 29-33)

Claim 11: Bahar discloses a commercial article developing method comprising:

- a. Submitting a questionnaire including a plurality of questions, each question being directed to an element characterizing the commercial article. (Col 5, lines 36 – 56, and Fig. 3)
- b. Obtaining pieces of answer information each specifying at least an option selected by a participant from options corresponding to the element. (Col 6, lines 29-32 and lines 13-16).
- c. Specifying an adopted option corresponding to the element, based on the obtained pieces of answer information. (Col 6, lines 29-41).
- d. Developing a design of the commercial article on the based on the adopted option specified for each element. (Col 6. lines 37-39)

Claim 12. Bahar discloses a method of designing of a product having a plurality of elements, the method comprising:

- a. Obtaining information from participants regarding preferred embodiments of each element using a multiple-choice questionnaire. (Col 5, lines 36 – 56, and Fig. 3)
- b. Determining a design of the product in which each element is executed according to an embodiment selected by most participants. (Col 6, lines 29-41).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of Murphy (MM, MM ... BLUE! PUBLIC OBVIOUSLY WAS READY FOR A CHANGE IN M&M COLORS: [CITY Edition] Marli Murphy KANSAS CITY STAR. Dayton Daily News. Dayton Ohio: Aut 19, 1995. pg. 3.C).

Claim 2: Bahar discloses the method according to claim 1, but is silent with regard to the specific method in which the adopted option is elected. However, the analogous teachings of Murphy disclose a manufactured commercial article in which participants determined the design of a product enhancement based upon the option selected by most participants. Therefore, choosing the adopted option as the one identified as most desirable from participants would have been obvious to one of ordinary skill in the art at the time of the application. One would have been motivated to do this in order to allow the manufacture to design a product that will maximize potential sales based upon identified user trends. In fact, Bahar mentions (Col 6, lines59-63) that such identification would benefit the manufacturer.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of Crane (Burton Crane "The Sophisticated Investor", 1964. Crane (page 230, lines 3-14)

Claim 4: Bahar discloses the method according to claim 1, but is silent with regard to how the participant reward is calculated. It is old and well known in the market research art that when clients request a survey to be conducted that they will pay a set fee to the market research firm for conducting the survey. It is also well known in the market research art that survey participation increases when a reward is provided to the participant. The total amount of rewards provided must be less than the fee received in order to maintain profitability. The teachings of Crane, disclose a method for distributing rewards (dividends) to participants (share holders) that involves determining "a unit return value" and multiplying the unit return value by the number of participant points (shares owned). Using the Crane payment distribution methodology in the invention of Bahar would have been obvious to one of ordinary skill in the art at the time of the application. One would have been motivated to do this in order to provide a reward to a participant that is commensurate with the amount input they provided. This would provide an enticement for continued participation and provide participants with a sense of accomplishment.

Additionally, the Applicant's specification provides no positive motivation regarding the use of the disclosed payment methodology over other well-known

methods for reimbursing participants in a survey. It appears to be an arbitrary design consideration, which fails to patentably distinguish over Bahar et al..

Therefore, it would have been an obvious matter of design choice to modify Bahar et al. to obtain the invention as specified in the claim(s).

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of West et al. (U.S. Patent Number: 6,175,833).

Claim 5: Bahar discloses a method according to claim 1, but is silent regarding transmitting the final results of the questionnaire to the participant. However, the analogous teachings of West disclose providing participants in a survey with the results of the survey (Col 9 lines 37-43). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate sending participant in the questionnaire of Bahar the final results of the survey. One would have been motivated to do this in order to allow participants to see how their opinions have affected the final design of the product and to encourage them to continue to participate in the future.

Response to Arguments

11. Applicant's arguments filed February 27, 2006 have been fully considered but they are not persuasive.

- a. Applicant argues that Bahar does not teach or suggest determining a final design of the product in which each element is as specified in the one adopted option. However, Bahar discloses the selection of a winning design based upon the submissions provided (Col 6, lines 30-41). The examiner considers this the adopted option, the design for which is based upon retrieved pieces of answer information.
- b. In response to applicant's argument that the examiner's conclusion of obviousness in Claim 2 is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
- c. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicant is

merely proposing an obvious and well-known formula for defining proportional distribution to participants. The art used consists of basic financial information that anyone with basic knowledge of payment distribution would be aware of. This type of basic knowledge would be required of anyone considering providing a payment or reward to participants in a survey like the one conducted in the Bahar reference. Additionally, the motivation for using this type of payment formula is taken directly from the Bahar reference.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is

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(571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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